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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,011	05/10/2001	Andrew Shay Woodard	PA-3003555	3987

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EXAMINER

NGUYEN, DUSTIN

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 08/03/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/852,011

Applicant(s)

WOODARD ET AL.

Examiner

Dustin Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4.8.9</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1 – 30 are presented for examination.

Claim Objections

2. Claims 14, 18, 19, 22, 25, are objected to because of the following informalities: they are depending on themselves. Appropriate correction is required.

3. Claims 15 and 24 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-12, 14-21, 24-30, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- A. The following terms lack antecedent basis:

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I. a method - Claims 2-12, 14-21, 24-30,
line 1.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-74 of copending Application No. 09/709,505 [hereinafter '505 application], claims 1-74 of copending Application No. 09/709,506 [hereinafter '056 application], and claims 1-51 of copending Application No. 09/736,223 [hereinafter '223 application]. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Taking claim 1 as an exemplary claim, the '505, '506, '223 applications contain the subject matter claimed in the instant application. As per claim 1, all applications are claiming common subject matter, as follows:

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A method for remotely extracting and storing computer related information across a network, said method comprising:

- establishing a communication link ...;
- downloading a software module ...;
- transferring a first directive file ...;
- said remote server system ...;
- receiving from said software module ...;
- transferring a third directive file ...;
- said remote server ...; and
- said remote server system parsing

The claim of '505, '506, '223 applications do not specifically disclose the same process steps performed as described in the claim 1 of instant application but it would have been obvious for a person skill in the art to recognize that the claims are similar because they perform the functions of parsing and processing instruction to achieve the purpose of transferring information from one device to another.

As per independent claims 13, and 23, they are also directed to the same subject matter recited in claim 1 above. Accordingly, they are provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

As per dependent claims 2-12, 14-22, 24-30, of instant application, they contain similar subject matter as claims of the '505, '506, and '223 applications. Accordingly,

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they are provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daswani et al. [US Patent No 6,477,565], in view of Kim [US Patent No 6,546,002].

10. As per claim 1, Daswani discloses the invention substantially as claimed including a method for remotely extracting and storing computer related information across a network, said method comprising:

a) establishing a communications link between at least one computer-based device and a remote server system [Figures 1 and 2; and col 6, lines 1-27];

c) transferring a first directive file from said remote server system to said software module, said first directive file working in conjunction with said remote server system, said software module identifying installed computer related information on said computer-based device [col 3, lines 49-63; and col 9, lines 27-37];

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d) said remote server system receiving a second directive file from said software module regarding said identified installed computer related information [col 9, lines 39-49].

Daswani does not specifically disclose

b) downloading a software module from said remote server system to said computer-based device;

e) receiving from said software module a selected list of installed computer related information to be uploaded to said remote server system;

f) transferring a third directive file from said remote server system to said software module, said third directive file working in conjunction with said remote server system and said software module extracting said selected list of installed computer-related information;

g) said remote server system receiving said extracted information from said software module in a fourth directive file, and

h) said remote server system parsing said fourth directive file and storing said extracted information.

Kim discloses

b) downloading a software module from said remote server system to said computer-based device [col 14, lines 49-54];

e) receiving from said software module a selected list of installed computer related information to be uploaded to said remote server system [col 11, lines 19-38];

f) transferring a third directive file from said remote server system to said software module, said third directive file working in conjunction with said remote server

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system and said software module extracting said selected list of installed computer-related information [col 4, lines 25-41; and col 12, lines 34-38];

g) said remote server system receiving said extracted information from said software module in a fourth directive file [col 11, lines 61-col 12, lines 7], and

h) said remote server system parsing said fourth directive file and storing said extracted information [col 6, lines 22-24].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Daswani and Kim because Kim's teaching would provide a system and method that allows different applications and services to access user profile, configuration and setting information [Kim, col 4, lines 14-20].

11. As per claim 2, Daswani discloses wherein one or more of said directive files are created from an XML snippet database [col 2, lines 21-31].

12. As per claim 3, Daswani discloses wherein XML snippet database is periodically updated to include new and updated operating systems [col 10, lines 11-24].

13. As per claim 4, Daswani discloses wherein said step of transferring a first directive file from said remote server system to said software module further comprises: identifying an operating system associated with said computer-based device; said remote server system accessing said XML snippet database to identify XML snippets associated with said identified operating system, and adding said identified XML

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snippets to said first directive file [i.e. aggregate] [col 8, lines 1-14; and col 11, lines 54-60].

14. As per claim 5, Daswani discloses wherein said step of transferring a third directive file from said remote server system further comprises: said remote server system accessing said XML snippet database to identify XML snippets associated with said selected list of information, corresponding to identified installed applications, files, and other data, to be uploaded to said remote server system, and adding said identified snippets to said third directive file [col 8, lines 56-65].

15. As per claim 6, Daswani does not specifically disclose wherein said information comprises any of the following: hardware settings, system settings, attached device settings, application settings, document settings, desktop settings, e-mail settings, and address book settings. Kim discloses wherein said information comprises any of the following: hardware settings, system settings, attached device settings, application settings, document settings, desktop settings, e-mail settings, and address book settings [col 4, lines 18-21 and lines 34-41]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Daswani and Kim because Kim's teaching would allow user to access specific documents, programs, applications, etc... from any computer devices [Kim, col 3, lines 66-col 4, lines 4], which also add portability aspect to the system.

16. As per claim 7, it is rejected for similar reasons as stated above in claim 6.

17. As per claim 8, Daswani discloses wherein said computer-based devices include any of the following: personal computer systems, laptops, portable computers, net devices, palm computers or telephones [col 1, lines 39-44].

18. As per claim 9, Daswani discloses wherein said parsing of directive files is performed by an XML parser [col 2, lines 21-31].

19. As per claim 10, Daswani discloses wherein said directive files and said stored information are in a markup based format [col 5, lines 38-49].

20. As per claim 11, Daswani discloses wherein said markup format is any of the following formats: HTML, SGML, XML or WML [col 8, lines 60-62].

21. As per claim 12, Daswani discloses wherein said remote server system is located within an enterprise server system [col 2, lines 21-27; and col 7, lines 16-18].

22. As per claim 13, it is rejected for similar reasons as stated above in claims 1 and 2.

23. As per claims 14-20, they are rejected for similar reasons as stated above in claims 6-10 and 11.

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24. As per claims 21 and 22, they are rejected for similar reasons as stated above in claims 2 and 3.

25. As per claim 23, it is rejected for similar reasons as stated above in claims 1 and 2.

26. As per claims 24-29, they are rejected for similar reasons as stated above in claims 6-10 and 12.

27. As per claim 30, it is rejected for similar reasons as stated above in claim 3.

28. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (703) 305-5321. The examiner can normally be reached on Monday – Friday (8:00 – 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directly to the receptionist whose telephone number is (703) 305-3900.

Dustin Nguyen



ZARNI MAUNG
PRIMARY EXAMINER